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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. | | | | |
|---|--------------------|----------------------|---|------------------|---------------|------------|--------------|--|
| 10/822,920 | 04/13/2004 | Eric Zitaner | 52531.100001 (CON) | 3562 | | | | |
| 20786 KING & SPALDING LLP 1180 PEACHTREE STREET ATLANTA, GA 30309-3521 | 7590 12/07/2007 | | <table border="1"><tr><td colspan="2">EXAMINER</td></tr><tr><td colspan="2">WONG, LESLIE</td></tr></table> | | EXAMINER | | WONG, LESLIE | |
| EXAMINER | | | | | | | | |
| WONG, LESLIE | | | | | | | | |
| | | | <table border="1"><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td>2164</td><td></td></tr></table> | ART UNIT | PAPER NUMBER | 2164 | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

RA

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|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 10/822,920 | | ZITANER ET AL. | |
| | Examiner | | Art Unit | |
| | Leslie Wong | | 2164 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Receipt of Applicant's Amendment, filed 06 September 2007, is acknowledged.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 17-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Havens** (US 5924072 A) in view of **Parsons** (US 6411939 B1) and further in view of **Tremaine** (US 5819231 A).

Regarding claim 17, **Havens** teaches a competitive rewards database system (i.e., database 30 in Fig. 1; col. 9, line 29 – col. 10, line 24) comprising:

a). a competitive reward database operative to receive raw competitive rewards data comprising competitive rewards data for employees of an entity and (col. 6, line 62 – col. 7, line 1; col. 7, lines 13-22);

c). a computer system, coupled to the competitive rewards database via data communications channel, operative to provide the competitive rewards data for employees of the entity to the competitive rewards database on behalf of the entity (col. 3, lines 19-22 and 30-35), and

d). a rewards workbench configured to (Examiner interprets configured as programmed to) query the competitive rewards database in support of analysis (col. 7, lines 13-22).

Havens does not explicitly teach the steps of:

a). receiving competitive rewards data from a plurality of sources other than the entity.

b). data mapping table for automatically mapping the raw competitive rewards data prior to incorporation into the competitive rewards database by mapping the raw competitive rewards data to benchmarks comprising job function, discipline or scope.

Parsons, however, teaches the step of:

a). receiving competitive rewards data from a plurality of sources other than the entity (col. 11, lines 40-51).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Parsons'**

teaching would have allowed **Havens'** to provide due diligence on the replacement plan by preparing a comparative study for providing compliance information on the benefits as suggested by **Parsons** col. 11, lines 47-60.

Havens and Parsons do not explicitly teach the steps of:

- b). data mapping table for automatically mapping the raw competitive rewards data prior to incorporation into the competitive rewards database by mapping the raw competitive rewards data to benchmarks comprising job function, discipline or scope;
- d). the mapped competitive rewards data.

Tremaine, however, teaches the steps of:

data mapping table for automatically mapping the raw competitive rewards data prior to incorporation into the competitive rewards database by mapping the raw competitive rewards data to benchmarks comprising job function, discipline or scope as the job code file 26 may include a listing of one or more job codes 75 and their corresponding titles 76... For each job code, the job code file 26 may also include a salary guideline and a total compensation guideline 80 (col. 5, lines 5-15).

- d). the mapped competitive rewards data (Fig. 3A).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because

Tremaine's teaching would have allowed **Havens- Parsons'** to provide compensation planning which determine the salary and bonuses paid to each employee by month or the combined salary and bonuses paid to the employees as suggested by **Tremaine** col. 9, lines 62-66.

Regarding claims 18, 25, and 38, **Havens** further teaches wherein the competitive rewards data for the entity comprises employment data for the employees of the entity, the employment data comprising at least one of base pay data, long term incentive pay data and annual incentive pay data (col. 6, lines 35-43).

Regarding claim 19, **Havens** further teaches wherein the competitive rewards data contains at least one calculated data value (col. 6, lines 44-53).

Regarding claims 20-21, **Havens** further teaches a data capture tool operable to provide remote access to at least a portion of the competitive rewards database and wherein the rewards workbench is coupled to a data network and is configured to provide remote access to at least a portion of the competitive rewards database (col. 4, lines 9-31 and Fig. 1).

Regarding claims 22, 24, and 39, **Parsons** further teaches wherein the rewards workbench is configured to automate data feeds from the competitive rewards database to at least one third party human resources management system (col. 28, lines 10-15).

Regarding claims 23 and 37, **Havens** teaches method for administering a competitive rewards database comprising:

- a). receiving raw competitive rewards data comprising competitive rewards data for employees of an entity (col. 4, lines 32-51, col. 9, line 29 – col. 10, line 14);
- c). incorporating the mapped competitive rewards data into the records of the competitive rewards database (col. 5, lines 36-47 and col. 8, lines 18-63); and
- d). analyzing the mapped competitive rewards data by performing a competitive rewards analysis for one or more of the employees of the entity (col. 11, lines 21-45; col. 7, lines 13-22).
- e). generating a report presenting results of the analysis (col. 7, lines 13-22).

Havens does not explicitly teach the steps of:

- a). receiving competitive rewards data from a plurality of sources other than the entity.
- b). automatically mapping the raw competitive rewards data for incorporation into the competitive rewards database by mapping the raw competitive rewards data to benchmarks comprising job function, discipline, or scope.

Parsons, however, teaches the step of:

- a). receiving competitive rewards data from a plurality of sources other than the entity (col. 11, lines 40-51).

teaching would have allowed **Havens'** to provide due diligence on the replacement plan by preparing a comparative study for providing compliance information on the benefits as suggested by **Parsons** col. 11, lines 47-60.

Havens and Parsons do not explicitly teach the step of:

b). automatically mapping the raw competitive rewards data for incorporation into the competitive rewards database by mapping the raw competitive rewards data to benchmarks comprising job function, discipline, or scope;

Tremaine, however, teaches the steps of:

automatically mapping the raw competitive rewards data prior to incorporation into the competitive rewards database by mapping the raw competitive rewards data to benchmarks comprising job function, discipline or scope as the job code file 26 may include a listing of one or more job codes 75 and their corresponding titles 76... For each job code, the job code file 26 may also include a salary guideline and a total compensation guideline 80 (col. 5, lines 5-15).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Tremaine's** teaching would have allowed **Havens- Parsons'** to provide compensation planning which determine the salary and bonuses paid to each employee by month or the combined salary and bonuses paid to the employees as suggested by **Tremaine** col. 9, lines 62-66.

Regarding claim 26, **Havens** further teaches wherein the step of mapping the raw competitive rewards data comprises translating, scaling, reformatting or calculating portions of the raw competitive rewards data for compatibility with the benchmarks (col. 3, line 59 – col. 4, line 20).

Regarding claim 27, **Havens** further teaches the step of using a data capture tool to adjust the mapping of the raw competitive rewards data (col. 4, lines 9-31).

Regarding claims 28 and 40, **Havens** further teaches the step of using a rewards workbench to query the competitive rewards database in support of analyses of the mapped competitive rewards data, the analyses comprising at least one selected from a group comprising evaluation of prevalence of reward practices and plan provisions, comparison of member reward values to specific comparator groups, development of market reference data, model and development of base pay structure, analyses of competitive rewards cost implications, and data mining analyses (col. 7, lines 13-22; col. 3, lines 1-5; and col. 6, lines 5-9).

Regarding claims 29 and 41, **Tremaine** further teaches the step of using a rewards workbench to automate a data feed between the competitive rewards database (col. 4, lines 25-31).

Parsons at least one third party human resources management system that is not associated with the entity, thereby supporting a submission of certain mapped competitive rewards data in the form of a survey to the third party human resources management system (col. 37, lines 16-21)

Regarding claims 30 and 42, **Havens** further teaches wherein the step of analyzing the mapped competitive rewards data comprises a competitive rewards analysis, a total compensation planning analysis or a performance-based analysis (col. 7, lines 13-22).

Regarding claims 31 and 43, **Havens** further teaches wherein the step of receiving the raw competitive rewards data comprises receiving the raw competitive rewards data at the competitive rewards database on a periodic basis (col. 7, lines 13-31 and col. 8, lines 12-32).

Regarding claims 32 and 44, **Havens** further teaches wherein the step of receiving the raw competitive rewards data comprises:

 sending a polling signal from the competitive rewards database to a computer system operated on behalf of the entity (col. 8, lines 12-32); and

 responsive to the polling signal, transmitting the competitive rewards data for the employees of the entity from the computer system to the competitive rewards database (col. 8, lines 12-32).

Regarding claims 33 and 45, **Havens** further teaches wherein the data mapping step comprises using a data mapping table to map without manual intervention the raw competitive reward data (col. 5, lines 19-31).

Havens does not explicitly teach competitive reward data based on benchmark global job matches.

Parsons, however, teaches competitive reward data based on benchmark global job matches (col. 2, lines 41-51; col. 3, lines 10-15; col. 4, lines 17-19; and col. 37, lines 54-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Parsons'** teaching would have allowed **Havens'** to provide cross-border solution for implementing the compensation/benefit plans as suggested by **Parsons** col. 2, lines 45-51.

Regarding claim 34, **Havens** further teaches wherein the step of generating a presentation of results comprises generating a report in response to completing the analysis of the competitive rewards data (col. 7, lines 13-22).

Regarding claim 35, **Havens** further teaches wherein the step of analyzing the mapped competitive rewards data generates an up-to-date mapping for competitive rewards data of the employees for the entity to at least one of the benchmarks (col. 13, lines 12-20).

Regarding claims 36 and 46, **Havens** further teaches wherein the step of analyzing the mapped competitive rewards data comprises a comparison of the competitive rewards data for the employees of the entity to one of the benchmarks maintained by the competitive rewards database (col. 14, lines 30-65).

Response to Arguments

4. Applicant's arguments filed 06 September 2007 have been fully considered but they are not persuasive.

Applicant argues that Havens does not disclose or suggest storing raw competitive data and that Applicant traversed the Examiner's assertions that Haven discloses the above. And then Applicant went on to argue how Havens does not suggest or teach the limitation receiving raw competitive rewards data from multiple sources for incorporation into a database as recited by Claims 17, 23, and 37.

In response to the preceding arguments, Examiner respectfully submits that claim 18 recites that "... the competitive rewards data for the entity comprises **employment data** for the employees of the entity, the employment data comprising at least one of base pay data, long term incentive pay data and annual incentive pay data." Havens teaches storing raw competitive data as incentives may include any acknowledgments, commendations, tangible or intangible rewards, incentive credits for

accumulations ...col. 6, lines 38-46 and Fig. 1, element 24. As such, **Havens** teaches storing raw competitive data. As for the limitation "receiving raw competitive rewards data from multiple sources for incorporation into a database", the previous Action on page 4 stated that **Havens** does not explicitly teach the steps of:

- a). receiving competitive rewards data from a plurality of sources other than the entity.
- b). automatically mapping the raw competitive rewards data for incorporation into the competitive rewards database by mapping the raw competitive rewards data to benchmarks comprising job function, discipline, or scope.

Parsons, however, teaches the step of:

- a). receiving competitive rewards data from a plurality of sources other than the entity (col. 11, lines 40-51).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Parsons'** teaching would have allowed **Havens'** to provide due diligence on the replacement plan by preparing a comparative study for providing compliance information on the benefits as suggested by **Parsons** col. 11, lines 47-60.

As such, **Havens** and **Parsons** in combination teach the limitation as claimed.

Next, Applicant argues that Parson is directed to a system for comparing current and replacement benefit plans, as opposed to receiving competitive rewards data from a plurality of sources other than an entity and that no where in this process is competitive rewards data received from a plurality of sources other than entity as recited by claims 17, 23, and 37 of the present application.

In response to the preceding arguments, Examiner respectfully submits that **Havens** teaches “competitive rewards data” as pointed out from the above, but **Havens** does not explicitly teach the step of “receiving competitive rewards data **from a plurality of sources other than the entity**”. **Parsons** teaches “receiving ... data from a plurality of sources other than the entity” as a request for a comparative study for providing equivalent benefits for the consultant’s client. The Consultant’s Computer can identify the plans(s) to be illustrated and replaced. The necessary plan sponsor and participants’ data can also be transmitted or otherwise communicated (col. 11, lines 40-51). In this case, competitive rewards data or plan benefits are non-functional descriptive data.

The difference is simply a rearrangement of non-functional descriptive material. (Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404[fed, /Cir. 1983]).

Parsons’ teaching allows a request to be submitted to identify sources so that they can receive more data from multiple sources for a competitive study. It would have been obvious to one skilled in the art to substitute Parson’s benefit’s data for “competitive rewards data” or any other kind of data to provide due diligence on the

Parsons' teaching allows a request to be submitted to identify sources so that they can receive more data from multiple sources for a competitive study. It would have been obvious to one skilled in the art to substitute Parson's benefit's data for "competitive rewards data" or any other kind of data to provide due diligence on the received data to prepare case studies or sensitivity analysis (col. 11, line 65 col. 12, line 6).

Finally, Applicant argues that **Tremaine** does not disclose mapping competitive rewards data from multiple entities as required by claims 17, 23, and 37 and that the combination of **Havens, Parsons, and Tremaine** would not provide the solution of Claims 17, 23, and 37.

In response to the preceding arguments, Examiner respectfully submits that **Tremaine** teaches "mapping competitive rewards data" as for each job code, the job code file may also include a salary guideline and a total compensation guideline (col. 5, lines 11-12) and ... the job codes and associated information may be automatically loaded into the compensation planner... the overview information may include a current total compensation and a planned total compensation (col. 5, lines 46-68 and col. 5, lines 55-62) . As for the limitation "from multiple entities" **Parsons** is cited for such teaching as pointed out from the above.

Applicant's invention is related to a competitive rewards benchmarking system in an effort to better recruit or retain talents. The applied prior arts **Havens** is related to a

knowledge management system generates incentives for desirable knowledge worker activities and stores these incentives in activities records that represent different perspectives from which information related to knowledge items may be viewed, appreciated, and applied to benefit the organization. **Parsons** is directed to data processing and data management having particular utility in the filed of employee benefits, insurance, and compensation data (col. 1, lines 21-25). Finally, **Tremaine** is drawn to a compensation planning tool which receive and store compensation information includes a current salary, a current bonus, ... salary guideline etc... (Abstract). These prior arts teach similar subject matters and are in the same field of endeavor of the claimed invention. Therefore, it is submitted that combining **Havens, Parsons, and Tremaine** would have arrived at the claimed invention.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Wong whose telephone number is (571) 272-4120. The examiner can normally be reached on Monday to Friday 9:30am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHARLES RONES can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Leslie Wong
Primary Patent Examiner
Art Unit 2164